



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
087574,461	11/30/95	BARONE	100207-0700

18M2/0130
VERN NORVIEL
TOWNSEND AND TOWNSEND AND CREW
STEUART STREET TOWER
ONE MARKET PLAZA 20TH FLOOR
SAN FRANCISCO CA 94105

EXAMINER MUSTON

ART UNIT 1818	PAPER NUMBER
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DATE MAILED: 01/30/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/574,461

Applicant(s)
A.D. Barone et al.

Examiner
Neal A. Musto

Group Art Unit
1818



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire ~~on or before~~ thirty days, ~~which ever is longer~~, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-36 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-36 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-15, drawn to methods of monitoring polymer array synthesis and the effects of altering the synthetic protocol, classified in class 436, subclass 518.
 - II. Claims 16-19, drawn to a detectable monomeric polymer synthesis reagent, classified based on the chemical structure of the reagent.
 - III. Claims 20-24, drawn to a labeled nucleotide array of defined structure attached to a solid substrate, classified in class 536, subclass 25.32.
 - IV. Claims 25-31, drawn to a method of post synthetically labeling an oligonucleotide array, classified in class 436, subclass 546.
 - V. Claims 32-36, drawn to a post-synthetic labeling linker, classified based on the chemical structure of the linker.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions of group II, group III and group V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are distinct because they are unique chemical entities having different functions and effects, wherein group II comprises a monomeric

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polymer synthesis reagent, group III comprises an array of polymeric nucleotides attached to a solid substrate and group V comprises a reagent for post-synthetically labeling.

3. Inventions of group I and group IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are distinct as being different methods having different modes of operation and different functions. Group I involves methods of monitoring polymer array synthesis and the effects of alterations of said protocols, whereas group IV is drawn to methods of post-synthetically labeling oligonucleotide arrays. The function of group IV is to be able to detect to polymer array, whereas the methods of group are directed to monitoring the process and the effects of alteration that could be practiced without the process of group IV.

4. Inventions groups I, IV and Groups II, III, V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the labeling method disclosed in group IV can be practiced with a different product than that described in group V. In addition, the methods disclosed in group I can be practiced with other product than those disclosed (viz., namely either the products of groups II or V).

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5. Inventions of group III and groups I, IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the solid phase labeled polymer array of group III have different uses, wherein the array can be used to discover chemicals of biological significance and the methods are useful to monitor the production of said arrays..

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

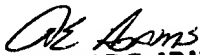
7. A telephone call was made to Eugenia Garrett-Wackowski on 15 Jan 1997 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neal A. Musto, Ph.D. whose telephone number is (703) 305-4505. The examiner can normally be reached Monday through Friday from 8:30 am to 5:00 pm. A message may be left on the examiners voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald E. Adams, Ph.D. can be reached at (703) 308-0570. The fax phone number for Group 1800 is (703) 305-7939 or (703) 308-4242. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1800 receptionist whose telephone number is (703) 308-0196.


DONALD E. ADAMS
SUPERVISORY PATENT EXAMINER
GROUP 1800

Neal A. Musto, Ph.D.
08574461.RES
January 24, 1997
